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EXAMINER				
FOGARTY, CAITLIN ANNE				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/579,798

Applicant(s)

YAGUCHI ET AL.

Examiner

CAITLIN FOGARTY

Art Unit

1793

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-20 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 18 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 10, 2009 has been entered.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Status of Claims

3. Claims 1 – 20 are pending where claims 1 and 2 have been amended.

Status of Previous Rejections

4. The 35 U.S.C. 103(a) rejection of claims 1 – 4, 6 – 9, 13 – 15, and 17 – 20 as being unpatentable over JP 2003-253390 has been maintained.

The 35 U.S.C. 103(a) rejection of claims 1 – 5, 7 – 12, and 17 – 20 as being unpatentable over JP 2001-207240 has been maintained.

The 35 U.S.C. 103(a) rejection of claim 16 as being unpatentable over JP 2001-207240 in view of JP 2003-253390 has been maintained.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1 – 4, 6 – 9, 13 – 15, and 17 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2003-253390 from the IDS (hereinafter JP '390).

With respect to instant claim 1, the abstract, [0005]-[0007] and [0026] disclose a low-carbon sulfur-based free machining steel product excellent in finished surface roughness with a clearly overlapping composition as seen in Table 1 below.

Table 1

Element	Instant Claim 1 (mass%)	JP '390 (mass %)	Overlapping Range (mass %)
C	0.02 – 0.12	0.02 – 0.15	0.02 – 0.12
Si	≤ 0.01	≤ 0.01	≤ 0.01
Mn	1.0 – 2.0	0.50 – 2.0	1.0 – 2.0
P	0.05 – 0.20	0.05 – 0.20	0.05 – 0.20
S	0.35 – 0.60	0.15 – 0.50	0.35 – 0.50
N	0.007 – 0.03	0.002 – 0.02	0.007 – 0.02
Fe + impurities	Balance	Balance	Balance

JP '390 also teaches that the average width (μm) of sulfide inclusions in the steel product is $2.8 \cdot \log(d)$ or more where d is the diameter (mm) of the steel product ([0005]). Furthermore, paragraph [0033] of JP '390 teaches that the steel product has a ferrite-pearlite structure as its metallographic structure.

JP '390 does not specifically teach that the contents of Mn and S satisfy the recited formulas in instant claim 1. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v.*

Marburg, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

JP '390 does not specifically teach that the hardness HV of pro-eutectoid ferrite in the metallographic structure is 133 to 150. However, paragraph [0033] of JP '390 teaches that the metallographic structure contains pro-eutectoid ferrite. It would be expected that the free machining steel of JP '390 would have the same pro-eutectoid ferrite hardness in the metallographic structure as that of the instant application because a similar process is used to make the free machining steel of JP '390 (see paragraph [0007] of JP '390).

In regards to instant claim 2, the abstract, [0005]-[0007] and [0026] disclose a low-carbon sulfur-based free machining steel product excellent in finished surface roughness with a clearly overlapping composition as seen in Table 1 above. JP '390 also teaches that the average width (μm) of sulfide inclusions in the steel product is $2.8 \cdot \log(d)$ or more where d is the diameter (mm) of the steel product ([0005]). Furthermore, paragraph [0033] of JP '390 teaches that the steel product has a ferrite-pearlite structure as its metallographic structure.

JP '390 does not specifically teach that the contents of Mn and S satisfy the recited formulas in instant claim 2. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v.*

Marburg, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

JP '390 does not specifically teach that the difference in deformation resistance at a strain of 0.3 between 200°C and 25°C is 110 MPa or more and 200 MPa or less, the deformation resistances being determined at a deformation rate of 0.3 mm/min in a compression test. However, a similar process is used to make the free machining steel of JP '390 (see paragraph [0007] of JP '390) and the steel of the instant application. Therefore, it would be expected that the free machining steel of JP '390 would have the same deformation resistance.

Regarding instant claims 3 and 7, JP '390 does not specifically teach that the steel product further comprises 70 ppm or more of dissolved nitrogen. However, since the composition of nitrogen in the steel of JP '390 overlaps with that of the instant invention and a similar process is used to make each steel, it would be expected that the steel of JP '390 would contain an overlapping amount of dissolved nitrogen with the steel of the instant invention.

With respect to instant claims 4, 8, and 9, paragraph [0005] of JP '390 teaches that the steel comprises 0.01 mass% or less aluminum which is within the range recited in instant claim 4. JP '390 does not teach that the steel comprises Cr and therefore the steel of JP '390 satisfies the claim limitation of not more than 0.04 mass% Cr.

Since the claimed compositional ranges of claims 1-4 and 7-9 either overlap or are within the ranges disclosed by JP '390, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed free machining steel alloy composition from the free machining steel alloy composition disclosed by JP '390 because JP '390 teaches the same utility (i.e. free machining steel wire rod) in the whole disclosed range.

In regards to instant claims 6 and 13 – 15, paragraphs [0005] and [0020] of JP '390 teach that the steel is cast. JP '390 does not specifically teach that before casting, the free oxygen (Of) is controlled to a content of 30 ppm or more and less than 100 ppm and the ratio Of/S of Of to S is controlled to within a range from 0.005 to 0.030, Of and S being contained in the molten steel before casting. However, paragraphs [0005], [0011], and [0014] of JP '390 disclose that the content of S in the steel is 0.15 - 0.50 mass% and the content of O in the steel is 0.01 - 0.03 mass%. The compositional ranges of S and O overlap with the compositional ranges recited in the instant application. Since the compositional ranges of S and O overlap, it would be expected that the ratio of free oxygen to sulfur of JP '390 would overlap with that of the instant invention.

Regarding instant claims 17 – 20, paragraphs [0001] and [0002] of JP '390 teach that the steel product may be in the form of a nipple, screw, or wire rod. JP '390 does not specifically teach that the steel product may be in the form of a steel bar. However, claims 17 – 20 recite intended uses of the product and an intended use is not

considered a limitation and is of no significance to the claim construction. See MPEP 2111.02 II.

7. Claims 1 – 5, 7 – 12, and 17 – 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2001-207240 from the IDS (hereinafter JP '240).

With respect to instant claim 1, the abstract and [0007]-[0009] of JP '240 disclose a low-carbon resulturized free machining steel product with a clearly overlapping composition as seen in Table 2 below.

Table 2

Element	Instant Claim 1 (mass%)	JP '240 (mass %)	Overlapping Range (mass%)
C	0.02 – 0.12	$0 < C < 0.15$	0.02 – 0.12
Si	≤ 0.01	≤ 0.05	≤ 0.01
Mn	1.0 – 2.0	0.3 – 2	1.0 – 2.0
P	0.05 – 0.20	≤ 0.2	0.05 – 0.20
S	0.35 – 0.60	0.08 – 0.5	0.35 – 0.50
N	0.007 – 0.03	≤ 0.01	0.007 – 0.01
Fe + impurities	Balance	Balance	Balance

JP '240 does not teach that the contents of Mn and S satisfy the recited formulas in instant claim 1. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

JP '240 differs from instant claim 1 because it does not teach that the steel product has excellent finished surface roughness or a ferrite-pearlite structure as its metallographic structure, wherein the average width (μm) of sulfide inclusion in the steel product is $2.8 \cdot \log(d)$ or more, wherein d is the diameter (mm) of the steel product, and pro-eutectoid ferrite in the metallographic structure has a hardness HV of 133 to 150. However, the steel product of JP '240 is made using a similar method to that of the instant application (see [0036]-[0038]) and therefore would be expected to have the same microstructure and characteristics since the compositions overlap.

In regards to instant claim 2, the abstract and [0007]-[0009] of JP '240 disclose a low-carbon resulfurized free machining steel product with a clearly overlapping composition as seen in Table 2 above.

JP '240 does not specifically teach that the contents of Mn and S satisfy the recited formulas in instant claim 2. However, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. *In re Austin, et al.*, 149 USPQ 685, 688.

JP '240 does not specifically teach that the steel product has excellent finished surface roughness or a ferrite-pearlite structure as its metallographic structure, wherein the average width (μm) of sulfide inclusion in the steel product is $2.8 \cdot \log(d)$ or more,

wherein d is the diameter (mm) of the steel product, and the difference in deformation resistance at a strain of 0.3 between 200°C and 25°C is 110 MPa or more and 200 MPa or less, the deformation resistances being determined at a deformation rate of 0.3 mm/min in a compression test. However, the steel product of JP '240 is made using a similar method to that of the instant application and therefore would be expected to have the same microstructure, characteristics, and deformation resistance since the compositions overlap.

Regarding instant claims 3 and 7, paragraph [0018] of JP '240 teaches that the steel product comprises 0.01 mass% or less dissolved nitrogen which is within the range recited in instant claims 3 and 7.

With respect to instant claims 4, 5, and 8 – 12, paragraphs [0007]-[0009] and [0034] of JP '240 teach that the steel comprises 1 mass % or less Cr, Ni, V, Ti, and Nb and 0.05 mass% or less aluminum which are either within or overlap the ranges recited in instant claims 4, 5, and 8 – 12.

Since the claimed compositional ranges of claims 1-5 and 7-12 either overlap or are within the ranges disclosed by JP '240, a prima facie case of obviousness exists. See MPEP 2144.05. It would have been obvious to one of ordinary skill in the art at the time the invention was made to select the claimed free machining steel alloy composition from the steel alloy composition disclosed by JP '240 because JP '240 teaches the same utility (i.e. steel wire rod) in the whole disclosed range.

Regarding instant claims 17 – 20, paragraph [0001] of JP '240 teaches that the steel product may be in the form of a wire rod or a steel bar. JP '240 does not

specifically teach that the steel product may be in the form of a nipple or screw.

However, claims 17 – 20 recite intended uses of the product and an intended use is not considered a limitation and is of no significance to the claim construction. See MPEP 2111.02 II.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over the English machine translation of JP 2001-207240 from the IDS (JP '240) as applied to claims 1 and 5 above, and further in view of the English machine translation of JP 2003-253390 from the IDS (JP '390).

JP '240 is applied to claims 1 and 5 as discussed in the rejection above.

JP '240 differs from instant claim 16 because it does not teach that before casting the steel, the free oxygen (Of) is controlled to a content of 30 ppm or more and less than 100 ppm and the ratio Of/S of Of to S is controlled to within a range from 0.005 to 0.030, Of and S being contained in molten steel before casting.

However, the abstract, [0005]-[0007] and [0026] of JP '390 disclose a low-carbon sulfur-based free machining steel product excellent in finished surface roughness with an overlapping composition with the steel of JP '240. Furthermore, paragraphs [0005] and [0020] of JP '390 teach that the steel is cast. JP '390 does not specifically teach that before casting, the free oxygen (Of) is controlled to a content of 30 ppm or more and less than 100 ppm and the ratio Of/S of Of to S is controlled to within a range from 0.005 to 0.030, Of and S being contained in the molten steel before casting. However, paragraphs [0005], [0011], and [0014] of JP '390 disclose that the content of S in the steel is 0.15 - 0.50 mass% and the content of O in the steel is 0.01 - 0.03 mass%. The

compositional ranges of S and O overlap with the compositional ranges recited in the instant application. Since the compositional ranges of S and O overlap, it would be expected that the ratio of free oxygen to sulfur of JP '390 would overlap with that of the instant invention. It would have been obvious to one of ordinary skill in the art to use the method of casting with specific O and S concentrations as disclosed in JP '390 as an alternate method to make the steel of JP '240 because the final products have very similar and overlapping compositions.

Response to Arguments

9. Applicant's arguments filed March 10, 2009 have been fully considered but they are not persuasive.

Arguments are summarized as follows:

- a. Nearly all experimental examples in JP '240 and JP '390 contain S values lower than the required 0.35%. For at least this reason nearly all of the examples in the applied art cannot yield the claimed invention.
- b. Examples D4 and D5 in Table 1 of JP '240 and Steel 35/Comparative Example 43 on p. 50 of the instant specification do not yield the claimed invention. Therefore, products which did not include the specified requirements of the claimed invention were inferior.
- c. JP '240 and JP '390 do not teach, suggest, or recognize the result effective nature of Mn, S, and/or Mn*S, and thus would not lead one of ordinary skill in the art to modify the products disclosed therein to yield the claimed invention. It is only through hindsight, using the present application as a guide,

that the claimed invention and beneficial properties associated therewith can be obtained.

d. The comparative examples in the instant specification reflect the inescapable conclusion that the claimed, inventive steel having all of the required characteristics possesses improved properties as compared to steel which is similar but which does not include all of the required characteristics.

e. With respect to claim 1, at minimum, nothing in the applied art would lead one skilled in the art to the required $Mn \cdot S$ or Mn/S values. Nothing in the applied art recognizes these values as being result effective, meaning that one skilled in the art would not be motivated to optimize these values.

f. With respect to claim 2, at minimum, nothing in the applied art would lead one skilled in the art to the required deformation resistance properties, properties which reflect an improved steel product.

g. With respect to claims 3 and 7, at minimum, nothing in the applied art would lead one skilled in the art to the required dissolved nitrogen values. Nothing in the applied art recognizes these dissolved nitrogen values as being result effective, meaning that one skilled in the art would not be motivated to optimize these values.

h. With respect to claims 6 and 13-16, at minimum, nothing in the applied art would lead one skilled in the art to the required O_f concentrations and O_f/S ratios prior to casting, which are significant characteristics of the present invention. Nothing in the applied art recognizes these values prior to casting as being result

effective, meaning that one skilled in the art would not be motivated to optimize these values at that particular time in the production process.

Examiner's responses are as follows:

- a. The composition of S disclosed in both JP '240 and JP '390 overlaps with the amended composition of S recited in the instant claims as seen in Tables 1 and 2 above. Furthermore, the scope of JP '240 and JP '390 is not limited to the specific embodiments it teaches (see *In re Fracalossi* 215 USPQ 569 (CCPA 1982)).
- b. & d. The scope of JP '240 and JP '390 is not limited to the specific embodiments it teaches. Furthermore, Applicant has not submitted evidence to show the criticality of the instant recited formulas. Therefore, the Examiner maintains the position set forth in the rejections above.
- c. Applicant has not exhibited the criticality of the instant recited formulas on the result effective nature of Mn, S, and/or Mn*S. Therefore, the Examiner maintains the position set forth in the rejections above.
- e. Although neither JP '390 nor JP '240 specifically teaches that the contents of Mn and S satisfy the recited formulas in instant claim 1, the Examiner maintains the position that it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art. Furthermore, in the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those ordinary skilled in the art. Applicant has not submitted

factual evidence to show the criticality of a minimum of $0.50 \text{ Mn}\cdot\text{S}$ (i.e. compared to $0.49 \text{ Mn}\cdot\text{S}$) and a maximum of $0.8 \text{ Mn}\cdot\text{S}$ (i.e. compared to $0.81 \text{ Mn}\cdot\text{S}$) or the criticality of at least Mn/S of 3.0 (i.e. compared to Mn/S of 2.9).

f. Applicant has not submitted factual evidence to show that the steel product of JP '390 or JP '240 would not inherently have a difference in deformation resistance at a strain of 0.3 between 200°C and 25°C that is 110 MPa or more and 200MPa or less, the deformation resistances being determined at a deformation rate of 0.3 mm/min in a compression test. Therefore, the Examiner maintains the position that since a similar process is used to make the free machining steel of JP '390 and the steel product of JP '240, it would be expected that the steel products of JP '390 and JP '240 would have the same deformation resistance.

g. Applicant has not submitted factual evidence to show that the steel product of JP '390 or JP '240 would not have an overlapping amount of dissolved nitrogen. Therefore, the Examiner maintains the position that since the composition of nitrogen in the steel of JP '390 overlaps with that of the instant invention and a similar process is used to make each steel, it would be expected that the steel of JP '390 would contain an overlapping amount of dissolved nitrogen with the steel of the instant invention. Furthermore, [0018] of JP '240 teaches that the steel product comprises 0.01 mass% or less dissolved nitrogen which is within the range recited in instant claims 3 and 7.

h. JP '390 does not specifically teach that before casting, the free oxygen (Of) is controlled to a content of 30 ppm or more and less than 100 ppm and the ratio Of/S of Of to S is controlled to within a range from 0.005 to 0.030, Of and S being contained in the molten steel before casting. However, in absence of evidence to the contrary, the Examiner maintains the position that since the compositional ranges of S and O in the steel of JP '390 overlap with the compositional ranges of S and O in the instant application, it would be expected that the ratio of free oxygen to sulfur of JP '390 would overlap with that of the instant invention.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CAITLIN FOGARTY whose telephone number is (571)270-3589. The examiner can normally be reached on Monday - Friday 8:00 AM - 5:30 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1793

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/
Supervisory Patent Examiner, Art
Unit 1793

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